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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,522	07/28/2003	Wolfgang Neuberger	BJA311A	5162

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BOLESH J. SKUTNIK PhD, JD
515 Shaker Road
East Longmeadow, MA 01028

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT	PAPER NUMBER
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2873

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,522

Applicant(s)

NEUBERGER, WOLFGANG

Examiner

Jordan M. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9 and 10 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/28/03</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Specification***

The abstract of the disclosure is objected to because it is too long. Specifically, the abstract cannot exceed 150 words and it therefore needs to be shortened. Correction is required. See MPEP § 608.01(b) and 37 CFR 1.72.

Claim Objections

Claims 1 and 4-6 (and dependent claims 2-3, 7-10) are objected to for the following reasons: since the intended meaning could be determined from what is set forth in the specification and the Figures, 112 rejections were not made but instead these lack of clarity issues have been raised in the following objections.

With respect to claim 1, the "and/or" language creates a lack of clarity. It is suggested that applicant change that part of the claim to state "...is visible to third parties or to a person wearing said lens or both while said lens..." and this is the assumed meaning for purposes of examination.

With respect to claim 4, that part of the claim stating "wherein said shading area" creates a lack of clarity because applicant has not positively and distinctly claimed that the contact lens comprises a shaded area (since claim 3, from which claim 4 depends is claiming that the lens comprises either a shaded area or a tinted area). It is suggested that applicant change claim 4 to more positively recite the shaded area as a limitation such as "The safety contact lens of claim 3, comprising said shaded area, wherein said shaded area..." to provide the required clarity.

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With respect to claims 5-6, that part of the claim stating "wherein said tinted area" creates a lack of clarity because applicant has not positively and distinctly claimed that the contact lens comprises a tinted area (since claim 3, from which claim 4 depends is claiming that the lens comprises either a shaded area or a tinted area). It is suggested that applicant change claims 5 and 6 to more positively recite the tinted area as a limitation such as "The safety contact lens of claim 5, comprising said tinted area, wherein said tinted area..." (with a similar change to claim 6) to provide the required clarity.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Neeffe patent number 4,971,433.

Neeffe reads on these claims by disclosing the limitations therein including the following: a safety contact lens (abstract re contact lens and column 4, line 9, absorbing ultraviolet light harmful to the eye re "safety"); comprising means to protect an eye from harmful radiation (column 4, line 9); at least one identification area on the lens (column 2, lines 18-25 with the opaque pattern as an "identification area" since it is identifying the portion of the lens that is providing the coloring to the iris); the identification area visible to third parties while the lens

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is worn on the eye (column 3, line 50 in that since the lens coloring is changing the color of the iris with respect to a third party, then it is visible to a third party while the lens is worn. Furthermore, column 2, line 24 shows the pattern as indiscernible at a distance of two feet or greater so therefore the pattern is visible to a third person at distances closer than two feet i.e. the pattern is visible to a third party while the lens is worn on an eye). Neefe further discloses the harmful radiation as ultraviolet rays from the sun (column 4, lines 9-12 i.e. the harmful radiation as a "high power optical source"); the identification area as a tinted area or shaded area (column 2, lines 18-25 i.e. "colored opaque pattern"); and the identification area not overlaying the pupil of the eye (column 2, lines 13-15).

Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman patent number 5,617,154.

Hoffman reads on these claims by disclosing the limitations therein including the following: a safety contact lens (abstract re contact lens and column 1, lines 5-20 and column 2, line 45 to column 3, line 5, absorbing ultraviolet light harmful to the eye re "safety"); comprising means to protect an eye from harmful radiation (column 1, lines 5-20 and column 2, line 45 to column 3, line 5); at least one identification area on the lens (column 15, lines 1-25 and examples 4-11 with the "identification area" as the coloring portion of the lens that is identifying the different color of the lens); the identification area visible to third parties while the lens is worn on the eye (examples 4-11 with the different coloring of the lenses being visible to third parties). Hoffman further discloses the harmful radiation as ultraviolet rays from the sun (column 1, lines 5-20 and column 2, line 45 to

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column 3, line 5 i.e. the harmful radiation as a "high power optical source"); the identification area as a tinted area or shaded area (examples 4-11); and the identification area not overlaying the pupil of the eye (column 15, lines 4 and 18).

Claims 1-3 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen patent number 6,059,775.

Nielsen reads on these claims by disclosing the limitations therein including the following: a safety contact lens (Figure 1, column 3, line 45); comprising means to protect an eye from harmful radiation (column 3, line 45); at least one identification area on the lens (Figures 2B-2D with the "identification area" as the masked portions that identify the portions of the lens that block the laser light); the identification area visible to third parties while the lens is worn on the eye (column 3, lines 13-33 with the masked areas being visible to the surgeon). Nielsen further discloses the harmful radiation as laser light (column 3, lines 13-47); the identification area as a shaded area (Figures 2B-2D); the identification area not overlaying the pupil of the eye (Figure 2C or Figure 2D with the outer masking ring as the "identification area"); and the identification area as a ring at or near a periphery of the lens (Figure 2D with the outer masking ring as the "identification area").

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neefe or Hoffman in view of Rawlings et al patent number 5,120,121.

In reference to these claims, Neefe and Hoffman disclose as is set forth above but do not disclose the claimed shaded area as an area of altered surface texture to increase opacity. However, Neefe and Hoffman, as stated in the rejections above, both disclose the shaded area applied to the lens for the purpose of coloring the lens to change the iris coloring of the lens user. Rawlings teaches that in a colored contact lens having a shaded area for the purpose of coloring the lens to change the iris coloring of the lens user (column 5, line 56 to column 6, line 47) that it is desirable to use an altered surface texture for the purpose of providing an improved cosmetic effect (column 10, lines 27-45). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the tinted contact lenses of either Neefe or Hoffman as further comprising an altered surface texture since Rawlings teaches that in a colored contact lens having a shaded area for the purpose of coloring the lens to change the iris coloring of the lens user, that it is desirable to use an altered surface texture for the purpose of providing an improved cosmetic effect. Additionally, an increased textural pattern will inherently increase the opacity of the shaded area.

Prior Art Citations

Jahnke patent number 6,494,575 is being cited herein as a reference that could have been used as a teaching reference concerning the ring formed at or

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near a periphery of the lens, however, such a rejection would have been repetitive.

Allowable Subject Matter

Claims 5-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to claim 5, none of the prior art either alone or in combination, disclose or teach of the claimed safety contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed color of the tinted area chosen to correspond to at least one radiation parameter to which the contact lens is protective according to a preselected scheme. Specifically, with reference to claims 6-7, none of the prior art either alone or in combination, disclose or teach of the claimed safety contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed tinted area not visible under light in a normal visible range, and is only visible under light of a preselected wavelength range. Specifically, with reference to claim 8, none of the prior art either alone or in combination, disclose or teach of the claimed safety contact lens specifically including, as the distinguishing feature in combination with the other limitations, the claimed

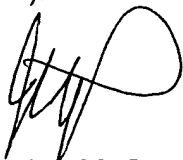
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identification area having visual attributes that vary according to given radiation parameters with the visual attributes unique to a given treatment or set of radiation parameters according to a preselected scheme.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached at (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz
Primary Examiner
Art Unit 2873
March 17, 2004